

Translation

PATENT COOPERATION TREATY

PCT

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY
(Chapter II of the Patent Cooperation Treaty)

(PCT Article 36 and Rule 70)

Applicant's or agent's file reference P-14-460-PCT	FOR FURTHER ACTION See Form PCT/IPEA/416	
International application No. PCT/EP2004/051198	International filing date (day/month/year) 22.06.2004	Priority date (day/month/year) 25.06.2003
International Patent Classification (IPC) or national classification and IPC		
Applicant NAGRACARD S.A.		

<p>1. This report is the international preliminary examination report, established by this International Preliminary Examining Authority under Article 35 and transmitted to the applicant according to Article 36.</p> <p>2. This REPORT consists of a total of <u>10</u> sheets, including this cover sheet.</p> <p>3. This report is also accompanied by ANNEXES, comprising:</p> <p>a. <input checked="" type="checkbox"/> (sent to the applicant and to the International Bureau) a total of <u>3</u> sheets, as follows:</p> <p><input type="checkbox"/> sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications authorized by this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions).</p> <p><input checked="" type="checkbox"/> sheets which supersede earlier sheets, but which this Authority considers contain an amendment that goes beyond the disclosure in the international application as filed, as indicated in item 4 of Box No. I and the Supplemental Box.</p> <p>b. <input type="checkbox"/> (sent to the International Bureau only) a total of _____, containing a sequence listing and/or tables related thereto, in computer readable form only, as indicated in the Supplemental Box Relating to Sequence Listing (see Section 802 of the Administrative Instructions).</p>	
<p>4. This report contains indications relating to the following items:</p> <p><input checked="" type="checkbox"/> Box No. I Basis of the report</p> <p><input checked="" type="checkbox"/> Box No. II Priority</p> <p><input type="checkbox"/> Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability</p> <p><input type="checkbox"/> Box No. IV Lack of unity of invention</p> <p><input checked="" type="checkbox"/> Box No. V Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement</p> <p><input type="checkbox"/> Box No. VI Certain documents cited</p> <p><input type="checkbox"/> Box No. VII Certain defects in the international application</p> <p><input type="checkbox"/> Box No. VIII Certain observations on the international application</p>	

Date of submission of the demand	Date of completion of this report
Name and mailing address of the IPEA/EP	Authorized officer
Facsimile No.	Telephone No.

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International application No.

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Box No. I

Basis of the report

1. With regard to the language, this report is based on the international application in the language in which it was filed, unless otherwise indicated under this item.
- ☐ This report is based on translations from the original language into the following language _____, which is the language of a translation furnished for the purposes of:
- ☐ international search (Rule 12.3 and 23.1(b))
- ☐ publication of the international application (Rule 12.4)
- ☐ international preliminary examination (Rule 55.2 and/or 55.3)
2. With regard to the elements of the international application, this report is based on (*replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report*):
- ☐ the international application as originally filed/furnished
- ☒ the description:
- pages 1-7 _____ as originally filed/furnished
- pages* _____ received by this Authority on _____
- pages* _____ received by this Authority on _____
- ☒ the claims:
- nos. _____ as originally filed/furnished
- nos.* _____ as amended (together with any statement) under Article 19
- nos.* 1-12 _____ received by this Authority on 15.04.2005 with letter
- nos.* _____ received by this Authority on of 12.04.2005
- ☒ the drawings:
- sheets 1/2, 2/2 _____ as originally filed/furnished
- sheets* _____ received by this Authority on _____
- sheets* _____ received by this Authority on _____
- ☐ a sequence listing and/or any related table(s) – see Supplemental Box Relating to Sequence Listing.
3. ☐ The amendments have resulted in the cancellation of:
- ☐ the description, pages _____
- ☐ the claims, nos. _____
- ☐ the drawings, sheets/figs _____
- ☐ the sequence listing (*specify*): _____
- ☐ any table(s) related to sequence listing (*specify*): _____
4. ☒ This report has been established as if (some of) the amendments annexed to this report and listed below had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).
- ☐ the description, pages _____
- ☒ the claims, nos. _____
- ☐ the drawings, sheets/figs _____
- ☐ the sequence listing (*specify*): _____
- ☐ any table(s) related to sequence listing (*specify*): _____

* If item 4 applies, some or all of those sheets may be marked "superseded."

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Box No. II Priority

1. ☐ This report has been established as if no priority had been claimed due to the failure to furnish within the prescribed time limit the requested:
 - ☐ copy of the earlier application whose priority has been claimed (Rule 66.7(a)).
 - ☐ translation of the earlier application whose priority has been claimed (Rule 66.7(b)).
2. ☐ This report has been established as if no priority had been claimed due to the fact that the priority claim has been found invalid (Rule 64.1). Thus for the purposes of this report, the international filing date indicated above is considered to be the relevant date.
3. Additional observations, if necessary:
See Supplemental Box.

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Box No. V	Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement		
1. Statement			
Novelty (N)	Claims	<u>1-9</u>	YES
	Claims		NO
Inventive step (IS)	Claims		YES
	Claims	<u>1-9</u>	NO
Industrial applicability (IA)	Claims	<u>1-9</u>	YES
	Claims		NO
2. Citations and explanations (Rule 70.7)			
1. In the present report, reference is made to the following documents:			
D1: US 6 385 723 B1 (RICHARDS TIMOTHY PHILIP) 7 May 2002 (2002-05-07);			
D2: EP 0 973 135 A (SONY CORP) 19 January 2000 (2000-01-19).			
2. The present application does not fulfil the requirements set forth in PCT Article 33(1), for the following reasons:			
2.1 Document D1 describes a method for allocating resources in a security module in an apparatus that is connected to a network (column 5, lines 51-55) administered by an operator (column 4, lines 30-35 and column 5, lines 51-55), which resources are used by application suppliers (column 5, lines 49-51). Said method involves the following steps in which:			
<ul style="list-style-type: none">a pair of asymmetrical keys are generated and the private key is stored in the			

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Box No. V	Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
	<p>security module while the public key is stored by an authority (column 7, lines 45-54 and column 8, lines 45-47),</p> <ul style="list-style-type: none">• at least one public key of said authority is inserted into the security module (column 10, lines 19-20),• a request is received by said authority from a supplier, which request includes at least the supplier's public key (column 9, lines 37-40),• a resource reservation instruction is transmitted, together with the supplier's public key, by said authority (via said supplier) to the security module (column 6, lines 28-34; column 9, lines 37-49; and column 10, lines 22-28),• the security module public key is transmitted by said authority to the supplier (column 8, lines 45-47 and column 11, lines 3-7),• secure communication is established between the supplier and the security module (column 10, paragraphs 48-52), and• an application is loaded in the security module by the supplier (column 10, paragraphs 48-52). <p><i>[N.B. According to document D1, the apparatus that is connected to a network is an ATM terminal. It is implicit that said ATM terminal is connected to a banking network administered by a bank. As a result,</i></p>

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Box No. V

Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability;
citations and explanations supporting such statement*said bank is the operator of said network.]*

It follows that the subject matter of claim 1 differs from this known resource allocation method in that the operator acts as an intermediary in interactions and communicates directly with the security module (and this enables the allocation of a specific resource designated by the operator).

[N.B. Indeed, if the authority and the operator were considered to be a single entity (the authority's functions are optionally assumed by the operator, for example, a bank, as indicated in the present application), interactions between the supplier, the security module and said entity, as described in document D1, would be identical to those defined in claim 1. As a result, the method in document D1 and the one defined in claim 1 differ by virtue of the distribution of functions between the operator and the authority].

In view of the method described in document D1, a person skilled in the art is faced with the problem of providing the operator with the means to control accurately the allocation of resources in the security module. A person skilled in the art, seeking to solve the stated problem, would turn to document D2, which relates to the same field of secure allocation of resources. Document D2 describes an allocation method in which the security module transmitter acts as an intermediary in interactions and addresses the

Box No. V	Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
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instructions necessary for allocating a specific resource directly to the card (column 16, paragraph 110 and figure 7). In light of this information, a person skilled in the art would adapt the method in document D1 in such a way that the security module transmitter (the operator) acts as an intermediary in interactions and transmits a reservation instruction for a specific resource to the security module. A person skilled in the art would, in this way, arrive at the subject matter of claim 1 without having to exercise any inventive skill (PCT Article 33(3)).

- 2.2 The dependent claims contain features that consist of implementation details or obvious options that a person skilled in the art might select, depending on each particular case, without an inventive step being involved. None of these features, in combination with the features of any one of the claims to which the dependent claims refer, fulfils the PCT requirement of inventive step (PCT Article 33(3)).

Supplemental Box

In case the space in any of the preceding boxes is not sufficient.

Continuation of:

Box I:

1. The amendments submitted with the letter dated 12 April 2005 cause the subject matter of the application to be extended beyond the content of the application as filed. As a result, said amendments are contrary to the provisions of PCT Article 34(2)(b). The amendments in question are as follows:
 - (a) Claim 1 defines a step in which "at least the supplier's public key is transmitted by said authority to the operator". This definition is not supported by the original application. According to the description, supplier FO transmits said supplier's public key to operator OP (paragraph 038) and said operator recovers said key in the event of a service request (paragraph 040). However, neither the description nor the figures mention that the authority transmits the supplier's public key to the operator. No such step can be directly and unambiguously derived from the fact that the operator recovers "the necessary information" from authority IS. Since the supplier's public key is transmitted to the operator (by the supplier him/herself), it cannot be considered to constitute "necessary information" that the operator would recover from authority IS.

Supplemental Box

(b) Claim 1 defines a step in which "at least part of the memory area dedicated to a resource is deactivated or deleted by said operator". This definition is not supported by the original application. According to the description, all of the memory area dedicated to a resource is deleted (paragraph 024).

(c) According to claim 2, the deactivation or deletion step involves deleting at least the supplier's public key. This definition is not supported by the original application. According to the description, the deactivation or deletion step involves deleting the supplier's key stored in the management portion (that also includes the definition of the dedicated resource areas) and deleting all of the memory area dedicated to a resource.

The amendments that cause the subject matter of the application to be extended beyond the content of the application as filed have not been taken into consideration for the international preliminary examination (PCT Rule 70.2(c)). In the case of the present set of claims, this amounts to carrying out the examination on the basis of the claims in the original application. As a result, the present report makes reference to claims 1 to 9 of the original application.

Supplemental Box

Box II:

1. The passages in the description that support claim 9 are not part of the application for which priority is claimed (EP03014209). As a result, claim 9 does not benefit from the claimed priority.